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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,680	03/05/2002	Carl A. Gunter	53087-5009	8503
28977	7590	12/04/2003	EXAMINER	
MORGAN, LEWIS & BOCKIUS LLP 1701 MARKET STREET PHILADELPHIA, PA 19103-2921			KLIMACH, PAULA W	
			ART UNIT	PAPER NUMBER
			2131	8
DATE MAILED: 12/04/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,680

Applicant(s)

GUNTER, CARL A.

Examiner

Paula W Klimach

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 8.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 and 3. 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This office action is in response to request for reconsideration filed on 9/26/03 (Paper No. 6). Original application contained Claims 1-5. Applicants also have made the appropriate adjustment overcome objection as identified in previous office action (Paper No. 4). The Form PTO-1449 for the Information Disclosure Statement and the Information Disclosure Statement are signed and copies included in the office action (Paper No. 8). The request for reconsideration filed on 9/26/03 have been entered and made of record. Therefore, presently pending claims are 1-5.

Response to Arguments

2. Applicant's arguments filed 9/26/03 have been fully considered but they are not persuasive because of following reasons.

Applicant argued that “*none of the references cited by the Examiner, alone or in combination, disclose step (d) of claim 1 namely: upon said first user transmitting the label to a second user via a messaging system, automatically storing on the web server information based on a public key of the second user and the label*”. This is not found persuasive, due to the new grounds of rejection; see 102 rejection to claim 1 below. Berry discloses a system in which a public key database holds information relating to public keys and a permission database holds information relating to the permissions (page 3 paragraph 0049). The label provides information related to the permission delegation and therefore storing the permissions is similar to storing the label.

The examiner asserts that the prior art does teach or suggest the subject matter broadly recited in independent Claims 1-5. Dependent Claims 2-4 are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action (Paper No. 8). Accordingly, rejections for claims 1-5 are respectfully maintained.

Claim Rejections - 35 USC § 101

3. The rejection of claims under 35 U.S.C section 101 are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

4. Claims 1-3, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Berry et al (US Patent 2002/0162019 A1).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

In reference to claims 1 and 5, Berry discloses a method and system of providing secure access to a service on a web server comprising: (a) providing a first user access to a label service on the web server (page 2 paragraph 0040); (b) allowing said first user to determine, using the label service, a label relating to the service on the web server (page 2 paragraph 0041); (c) providing the label to said first user (page 2 paragraph 0041); (d) upon said first user transmitting

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the label to a second user via a messaging system (paragraph 0042), automatically storing on the web server information based on a public key of the second, user and the label (page 3 paragraph 0049); (e) authenticating the second user with respect to the public key of the second user and the label (page 4 paragraph 0052); (f) providing the second user access to the service if step (e) produces a positive result (page 4 paragraph 0052).

Claims 2-3 are rejected as in rejection for claim 1.

Regarding claim 2, wherein the label comprises a URL for identifying the service (page 4 paragraph 0057).

Regarding claim 3, wherein the messaging system comprises an electronic mail system (page 3 paragraph 0049).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry as applied to claim 1 above, and further in view of Wright et al (2002/0016910 A1).

Berry does not expressly disclose the use of instant messaging for messaging.

Wright discloses messaging system comprises an instant messaging system (page 3 paragraph 0019).

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At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use instant messaging as in Wright in the system as in Berry. One of ordinary skill in the art would have been motivated to do this because instant messaging allows for delivery of messages the same day (page 1 paragraph 0007).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula W Klimach whose telephone number is (703) 305-8421.


The examiner can normally be reached on Mon to Thr 9:30 a.m to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (703) 305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4832.

PWK

Friday, November 28, 2003


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100